

**REMARKS**

**Status of the claims:**

Claims 36 – 47, 50 – 55, 58, 60 – 68, 88 – 93, and 131 – 139 are currently pending.

Claims 1 – 35, 48, 49, 56, 57, 59, 63, 69 – 87, 94 – 130 and 132 – 139 are cancelled.

Claims 63 and 132 – 139 are currently rejected.

Claims 36 – 47, 50 – 55, 58, 60 – 62, 64 – 68, 88 – 93 and 131 are allowed.

**Claim Amendments**

Claims 63 and 132 – 139 are cancelled in the instant response without prejudice or disclaimer.

**I. Rejection of Claim 139 Under 35 U.S.C. § 102(b)/103(a)**

Claim 139 stands rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, obvious under 35 U.S.C. § 103(a) over *Chen et al. "Chemical attachment of organic functional groups to single-walled carbon nanotube material," J. Mater. Res. 1998:13, pp. 2423 – 2431 (hereinafter, Chen).* Office Action page 2.

The Examiner alleges that *Chen* teaches single-wall carbon nanotubes, which the Examiner asserts is that which results when aryl substituents are added to SWNTs and then removed.

In the interest of expediting prosecution, Applicants hereby cancel claim 139 without prejudice or disclaimer and do not address the merits of the Examiner's rejection further. Applicants make no representation regarding the patentability of claim 139 and are not abandoning the subject matter of this or any other cancelled claim. Applicants reserve rights to file divisional or continuation applications on the subject matter of any of the cancelled claims at a time of Applicants' choosing.

In view of Applicants' cancellation of claim 139, the Examiner's rejection of this claim under 35 U.S.C. § 102(b)/103(a) is considered moot.

**II. Rejection of Claims 63 and 132 – 138 Under 35 U.S.C. § 103(a)**

Claims 63 and 132 – 138 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chen* and Applicants' alleged admissions. Office Action page 2.

The Examiner has acknowledged that *Chen* does not teach a polymer, although the Examiner alleges that Applicants admit that a polymer is known with SWNTs. The Examiner has required that if Applicants traverse the instant finding, then all articles, including those of the present inventors, published prior to the earliest effective filing date are to be submitted. The Examiner also alleges that using a polymer to make a useful composite material is an obvious expedient.

Applicants respectfully traverse the Examiner's allegation of an admission by Applicants. In the Office Action, the Examiner did not provide a precise location in which to find the alleged admission. In a telephone conversation with the Examiner conducted on June 18, 2009, the Examiner clarified that the alleged admission is "throughout" the 'Background of the Invention' section of Applicants' instant specification, without providing a more exact reference to its location.

Applicants are unable to locate any evidence of admitted prior art in the 'Background of the Invention' that teaches or suggests dispersing the derivatized carbon nanotubes in a polymer matrix, wherein the derivatized carbon nanotubes are the carbon nanotubes derivatized with an aryl moiety; and heating the derivatized carbon nanotubes; wherein the heating step removes at least a portion of the aryl moieties from the derivatized carbon nanotubes, as recited in Applicants' claim 63. In particular, the 'Background of the Invention' section contains no teaching or suggestion to combine dispersing carbon nanotubes in a polymer matrix with heating of the carbon nanotubes. Thus, Applicants respectfully assert that the 'Background of the Invention' is not an admission in the present case.

In view of the foregoing, Applicants respectfully assert that Applicants' disclosure does not contain admitted prior art that may be combined with *Chen* in rejecting claims 63 and 132 – 138. However, in the interest of expediting prosecution, Applicants hereby cancel claims 63 and 132 – 138 without prejudice or disclaimer and do not address the merits of the Examiner's rejection further herein. Applicants make no representation regarding the patentability of any of claims 63 and 132 – 138 and are not abandoning the subject matter of these or any other cancelled claim. Applicants reserve rights to file divisional or continuation applications on the subject matter of any of the cancelled claims at a time of Applicants' choosing.

In view of Applicants' cancellation of claims 63 and 132 – 138, the Examiner's rejection of these claims under 35 U.S.C. § 103(a) is considered moot. Although Applicants have traversed the Examiner's finding of an alleged admission, the Examiner's requirement for submission of articles by the present inventors is also considered moot in light of Applicants' cancellation of claims 63 and 132 – 138.

### **III. Non-Statutory Obviousness-Type Double Patenting Rejection**

Claims 63 and 132 – 138 stand rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1 – 16 of United States Patent 7,304,103. Office Action page 3.

Applicants have cancelled claims 63 and 132 – 138. Hence, the non-statutory obviousness-type double patenting rejection is considered moot.

### **IV. Status of Claims 36 – 47, 50 – 55, 58, 60 – 62, 64 – 68, 88 – 93 and 131**

Claims 36 – 47, 50 – 55, 58, 60 – 62, 64 – 68, 88 – 93 and 131 were allowed in an Office Action mailed October 24, 2008. In the instant Office Action mailed April 29, 2009, the Examiner did not reference the status of these claims. However, as the Examiner has cited no new art against these claims, and the claims have not been amended from their previously allowed form, Applicants presume that these claims remain allowed.

**V. Rejoinder of Non-Elected Multi-Wall Nanotube Species**

In the instant Office Action, the Examiner stated that the claims should be amended to reflect the election of SWNTs. Office Action, top of page 2. However, given that the still pending claims are generic and previously allowed, Applicants respectfully assert that such amendment is not necessary.

Claims in the instant application were previously subject to restriction in a restriction requirement mailed June 27, 2006. The restricted species were single-wall carbon nanotubes and multi-wall carbon nanotubes. In the restriction requirement, the Examiner acknowledged that all claims in the application were generic except those reciting SWNTs (see June 27, 2006 Office Action, page 2). Applicants made an election of single-wall carbon nanotubes (readable upon generic claims 36, 37, 39, 43 – 63, 67, 88, 89 and 91 – 93) in a response dated July 27, 2006. Applicants also presently assert that claims 64 – 66 and 131 are generic.

As provided by 37 CFR § 1.141, upon allowance of a generic claim, Applicants shall be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all of the limitations of an allowed generic claim.

"The propriety of a restriction requirement should be reconsidered when all the claims directed to the elected invention are in a condition for allowance, and the nonelected invention(s) should be considered for rejoinder.... In order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim...." MPEP § 821.04.

In view of the foregoing, Applicants respectfully request that the multi-wall carbon nanotube species be considered for rejoinder to the allowed generic claims.

**CONCLUSION**

Claims 36 – 47, 50 – 55, 58, 60 – 62, 64 – 68, 88 – 93 and 131 remain pending in the application. If additional fees are due and are not included, the Director is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 23-2426 of Winstead PC (referencing matter 11321-P022WUD1). If the Examiner has any questions or comments

concerning this paper or the present application in general, the Examiner is invited to call the undersigned at (713) 650-2764.

Respectfully submitted,

WINSTEAD PC

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Date: August 28, 2009

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